

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Office Action dated April 17, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Application. Claims 1, 9, 10 and 18 are independent claims. Claims 18-23 are added by this amendment.

In the Office Action, claims 1, 3, 4, 6-13, 15 and 16 are maintained as rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,676,284 to Willson (Willson) in view of U.S. Patent Publication No. 2004/0179000 to Fermgard (Fermgard). Claims 5, 14 and 17 are maintained rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Willson in view of Fermgard in further view of U.S. Patent No. 6,801,276 to Epstein ("Epstein"). These rejections are respectfully traversed. It is respectfully submitted that claims 1-23 are allowable over Willson in view of Fermgard alone and in view of Epstein for at least the following reasons.

It seems undisputed that Willson "lacks the teaching of the wires being protected from surroundings by a package of hot melt material." (See, Office Action, page 2.) Yet the Final Office Action comes to the conclusion that (emphasis added) "Wilson modified by Fermgard is capable of meeting the claimed limitation" of "the wires being environmentally protected from exposure to the surroundings."

However, it is respectfully submitted that the mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989). In this case, both Wilson and Fermgard do not teach that the wires are environmentally protected from exposure to the surroundings as apparently admitted in the Final Office Action (see, page 5, Response to Arguments section).

It is undisputed that Fermgard teaches that "[t]he light emitting diode is fixed by means of glue, for instance hot melt adhesive." (See, Fermgard, paragraph [0052], last line.) Yet the Final Office Action takes the position that simply because Fermgard

shows fixing with hot melt adhesive that "the LED and its wires would have to be protected from damage caused by exposure with the environment ...". It seems that since no such teaching of protection from exposure to environmental surroundings exists in either of Willson or Fermgard, the position is that the fixing shown by Fermgard would inherently protect the LED mounting and electric contacts to the connection wires from exposure.

If this is the case that the Final Office Action is taking the position that this is inherently shown by Wilson in view of Fermgard, Applicants respectfully note that a missing element is only inherently present in a reference if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art. Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or

1 The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgird v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).
Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Final Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.

It is respectfully submitted that nothing found in Wilson or Fremgard recites or suggests that the LED mounting and electric contacts to the connection wires are environmentally protected from

This citation is also set out in M.P.E.P. § 2131.01(d).

exposure to the surroundings by a package of hot melt material. One skilled in the art would recognize that Fermgard is not concerned with Environmental protection by the hot melt material since the LED and electrical wires in Fermgard are protected by a protective sheet of glass 26 (see, FIG. 3, paragraph [0052]).

It is respectfully submitted that the assembly of claim 1 is not anticipated or made obvious by the teachings of Wilson in view of Fermgard. For example, Wilson in view of Fermgard does not disclose or suggest or inherently show for that matter, an assembly that amongst other patentable elements, comprises (illustrative emphasis added) "LED mounting and electric contacts to the connection wires are environmentally protected from exposure to the surroundings by a package of hot melt material" as recited in claim 1, and as similarly recited in each of claims 9, 10 and 18. Epstein is introduced for allegedly showing elements of the dependent claims and as such, do nothing to cure the deficiencies in Wilson in view of Fermgard.

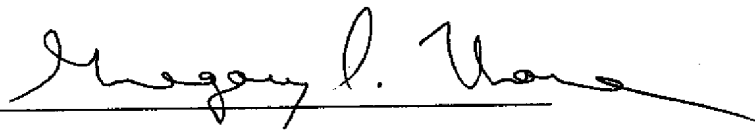
Accordingly, at least for these reasons, independent claims 1, 9, 10 and similarly 18 are believed to be patentable over Wilson in view of Fermgard.

Claims 2-8, 11-17 and 19-23 respectively depend from one of claims 1, 10 and 18 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims as previously discussed in quite some detail. Since the dependent claims are also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of claims 2-8, 11-17 and 19-23 on the merits is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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